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In re Application of

Leslie E. Smith et al.

Serial No. 10/743,936

Filed: December 23, 2003

For: FORMATION OF WIDE PAINT FILM PARTS

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: DECISION ON
: PETITION
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This is a decision on the PETITION UNDER 37 CFR 1.144 TO WITHDRAW THE RESTRICTION REQUIREMENT mailed November 16, 2004.

On November 16, 2004, a restriction requirement was made by the examiner. The examiner took the position that the groupings of claims were related as a method or making and product made. Applicants traversed the restriction requirement in a response filed February 1, 2005. In the response, Applicants cancelled the original product claims and presented a new group of product-by-process claims. It was argued that because the claims are in product-by-process form, they can not be made by a materially different process from that which is claimed. The examiner maintained the restriction requirement in the office action mailed on April 18, 2005.

On July 15, 2005, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that the separate groups are distinct and that no undue burden of search exists.

DECISION

Sections 803 and 806.05(f) of the MPEP state:

803 Restriction - When Proper

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - §

806.05(f) [R-3] Process of Making and Product Made *

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed

can be used to make **>another materially different product<; or (B) that the product as claimed can be made by another * materially different process.

Allegations of different processes or products need not be documented.

A product defined by the process by which it can be made is still a product claim (In re Bridgeford, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.

The examiner first made the restriction requirement in an office action mailed November 16, 2004. In the office action, the examiner takes the position that the product claims are patentably distinct from the process claims because the product as claimed could be made by a materially different process such as extrusion. This is a reasonable position in that the article claimed is directed to a plastic article. Turning to Applicant's own specification, it appears that these articles are in fact already known and commercially available (i.e. tonneau covers) albeit made by different means such as painting or coating the product after shaping (see pages 2-3).

Applicants did not provide any arguments directed to the position that the product could not be made by extrusion, but rather argued that because the claims were product-by-process claims, the restriction was improper. Petitioner takes the position that because the instant product claims are product-by-process claims, they can not be restricted because the product as claimed can not be made by another and materially different process. It is also argued that the product as claimed is not limited only by structural limitations, and the article is not to be examined solely on the basis of article structure. This argument is not persuasive. As stated above, a product defined by the process by which it can be made is still a product claim. The fact that a new process has been discovered to make a known product cannot impart patentability on that product. When examining a product-by-process claim, the examiner must take into account the process limitations only so far as they impart actual structural limitations to the final product. The claim is still directed to a product and therefore, only the actual structure of the product can impart patentability. The MPEP and the case law cited above, clearly allows for the restriction between process claims and the products formed by those processes. It is also noted that allegations of different processes need not be documented as argued by Petitioner. The mere assertion by Applicants that the product as claimed can not be made by extrusion, is insufficient to shift the burden back to the examiner, who set forth a reasonable position as to other methods of making the instantly claimed product.

Applicants also argue that there would be no undue burden of search for the examiner to examine all of the claims. In the original restriction requirement set forth by the examiner, the different groups are shown to be classified in different classes and subclasses. It is clear that a search of the method of making claimed would not require the same search as the articles claimed. While there would be an overlap in the searches, a search of the article itself would be much more extensive than the specific method claimed. Therefore a serious burden of search would exist for the examiner to have to examine both groups.

Accordingly, the restriction requirement is proper and the instant petition to withdraw the restriction requirement is **DENIED**. It is noted that applicants have filed an appeal brief which has been answered by the examiner. No further action is needed by the examiner at this time.



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